



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,929	06/01/2001	Richard Dean Dettinger	ROC920010022US1	1395
26517 7590 06/09/2010 WOOD, HERRON & EVANS, L.L.P. (IBM) 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202				
EXAMINER				
MIRZA, ADNAN M				
ART UNIT		PAPER NUMBER		
2445				
MAIL DATE		DELIVERY MODE		
06/09/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD DEAN DETTINGER and
FREDERICK ALLYN KULACK

Appeal 2009-006355
Application 09/871,929
Technology Center 2400

Decided: June 9, 2010

Before JOHN A. JEFFERY, HOWARD B. BLANKENSHIP, and
JAMES R. HUGHES, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-64. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

STATEMENT OF THE CASE

Appellants invented a system that provides services having information handling capabilities to a client computer. *See generally* Spec. 5. Claim 1 is illustrative:

1. A method of providing an information handling capability to a client computer system in a networked computer system comprising client and server computer systems, comprising the following steps performed at a server computer system:

identifying factors relevant to provision of said information handling capability by said client computer,

selecting one of at least a first and a second service to be uploaded to said client computer based upon said factors, said first and second services comprising different executable code for providing said information handling capability, and

delivering said selected service to said client computer system, so that said information handling capability may be realized by said client computer upon execution of code within said selected service at said client computer system.

The Examiner relies on the following as evidence of unpatentability:

Kikuchi	US 2001/0015975 A1	Aug. 23, 2001 (filed Feb. 21, 2001)
Taylor	US 2004/0088384 A1	May 6, 2004 (effectively filed May 14, 2001)

THE REJECTIONS

1. The Examiner rejected claims 15, 34, 49, and 62 under 35 U.S.C. § 101. Ans. 3.

2. The Examiner rejected claims 1-64 under 35 U.S.C. § 103(a) as unpatentable over Taylor and Kikuchi. Ans. 4-8.¹

CLAIM GROUPING

Regarding the § 101 rejection, since Appellants argue claims 15, 34, 49, and 62 together as a group (*see* Br. 9), we therefore select claim 15 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Regarding the § 103 rejection, we group the claims as follows: (1) claims 1, 2, 9, 12, 13, 15, 16, 18, and 19²; (2) claims 3, 14, and 17³; (3) claims 4-8, 10, and 11⁴; (4) claims 20-38; (5) claims 39, 45, and 48-51⁵; (6) claims 40-44, 46, and 47⁶; (7) claims 52, 58, and 61-64⁷; (8) claims 53-57,

¹ Throughout this opinion, we refer to (1) the Appeal Brief filed August 20, 2007 and (2) the Examiner's Answer mailed June 20, 2008.

² Appellants argue claims 1, 12, and 15 as a group (Br. 10-11) and do not separately address dependent claims 2, 9, 13, 16, 18, and 19.

³ Appellants argue claims 3, 14, and 17 as a group. Br. 11-12.

⁴ Appellants argue claims 4, 6, and 10 separately, but not claims 5, 7, 8, and 11. Br. 12. The issues for these claims, however, are similar and are therefore grouped accordingly.

⁵ Appellants argue claims 39, 48, and 49 as a group and do not address dependent claims 45, 50, and 51. Br. 13-14.

⁶ Appellants group claims 40, 42, and 46 with claims 4, 6, and 10 and do not argue claims 41, 43, 44, and 47. Br. 12. However, claims 40-44, 46, and 47 depend directly or indirectly from claim 39 and will be treated separately.

⁷ Appellants argue claims 52, 61, and 62 as a group and do not address dependent claims 58, 63, and 64. Br. 14.

59, and 60⁸. *See* Br. 10-14. Accordingly, we select claims 1, 3, 39, and 52 as representative of groups (1), (2), (5), and (7), respectively. *See* 37 C.F.R. § 41.37(c)(1)(vii).

THE NON-STATUTORY SUBJECT MATTER REJECTION

Regarding representative independent claim 15, the Examiner finds that the claim is directed to software. Ans. 3. Appellants argue that claim 15 recites “a computer readable media” storing the executable code and is not software. Br. 9.

The issue before us, then, is as follows:

ISSUE

Under § 101, has the Examiner erred in rejecting claim 15 by finding that the limitations are directed to non-statutory subject matter?

FINDINGS OF FACT (FF)

1. The Specification states the invention can be distributed as a program product, including a signal bearing media, such as “floppy disks (e.g., a floppy disk) and CD ROMS, and transmission type media such as digital and analog communication links, including wireless communication links.” Spec. 22:9-17.

⁸ Appellants group claims 53, 55, and 59 with claims 4, 6, and 10 and do not argue claims 54, 56, 57, and 60. Br. 12. However, claims 53-57, 59, and 60 depend directly or indirectly from claim 52 and will be treated separately.

PRINCIPLES OF LAW

Signals are not patentable subject matter under § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

ANALYSIS

Based on the record before us, we find no error in the Examiner finding representative claim 15 is directed to patent-ineligible subject matter. Claim 15 recites executable code and a computer-readable media storing the executable code. The Specification discloses computer-readable media include signal bearing media, such as transmission media or wireless links, to distribute the program product. *See* FF 1. The recited “computer-readable media” therefore encompasses a signal that performs the recited operations. Such signals are not patentable subject matter under § 101. *See Nuijten*, 500 F.3d at 1357.

We therefore find that claim 15, includes both statutory subject matter (instructions stored on a non-transitory media) and non-statutory subject matter (instructions conveyed by a signal or transitory media). According to USPTO guidelines, such claims must be amended to recite solely statutory subject matter. *See Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010); *see also* Manual of Patent Examining Procedure (“MPEP”) § 2106(IV)(C)(2)(2)(a), Rev. 6, Sept. 2007 (“[A] claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application.”)

For the foregoing reasons, independent claims 15, 34, 49, and 62 do not recite statutory subject matter under 35 U.S.C. § 101.

THE OBVIOUSNESS REJECTION OVER TAYLOR AND KIKUCHI

Claims 1, 2, 9, 12, 13, 15, 16, 18, and 19

Regarding representative independent claim 1, the Examiner finds that Taylor discloses all the recited limitations, except for the first and second services comprise different executable code for the information handling capabilities. Ans. 4. The Examiner relies on Kikuchi to teach the alleged missing limitation and to provide a reason to combine the references. Ans. 4-5.

Appellants argue that neither reference teaches the steps of identifying, selecting, or delivering. Br. 10. Appellants also contend that Taylor does not teach selecting services based on client factors (*id.*) or retrieving information based upon a client's profile or functionality (Br. 11). Appellants further assert that Kikuchi teaches monitoring data and not selecting or delivering different code services. Br. 11. Appellants argue the combination would not teach selecting between executable codes. Br. 11.

The issues before us, then, are as follows:

ISSUES

Under § 103, has the Examiner erred in rejecting claim 1 by finding that Taylor and Kikuchi collectively would have taught or suggested a server that:

(1) identifies factors relevant to a provision of the information handling capability;

(2) selects at least a first or second service uploadable to the client computer based upon the factors, the services having different executable codes to provide the information handling capability; and

(3) delivers the selected service to the client computer?

FINDINGS OF FACT

2. The Specification defines “service” as “executable code or [] executable process, or data utilized in such as process, or both, in any combination, that provides an information handling function” and “comprises client and server components, which interact to provide an information handling function, each component of which may include executable code, data, or both, in any combination.” Spec. 5:5-10.

3. The Specification provides examples of factors relevant to how the service is provided, including the client’s and server’s operating system, the connection speed and costs, the time of day, and the client’s and server’s location. Spec. 5:17-23, 11:13-12:2.

4. Taylor teaches a data management device for storing and retrieving data in response to a user request. Taylor, Abstract and Title.

5. Taylor discloses a demand pull algorithm for deciding whether to bring a product, title, and/or asset to a primary storage device, such as a streaming server. A product includes a purchasable item, such as a movie, package of movies, and subscription. Products contain assets (e.g., play track, fast play track, fast reverse track, preview track, navigation screens, promotional videos, JPEG still image associated with a title) and are defined by meta data (e.g., description, price, discount rules). Taylor, ¶¶ 0054-55.

6. Taylor teaches the product contains product rights information (e.g., viewing time, use time, price, purchase rules, encryption methodologies) that enables a host controller to determine what a customer may do with a particular product. Taylor, ¶ 0055.

7. Taylor explains that products are “published” to the application servers that present a user interface to customers, and that the products becomes elements of the customer’s overall user interface, either as graphical or video imagery or web page information. Taylor, ¶ 0056.

8. Taylor incorporates Gordon (US 6,208,335 B1) by reference to discuss methods for providing the graphical and video imagery or web page information. Gordon shows examples of the user interface and discusses transmitting applets (e.g., 500) from the server to the terminal to the implement the menus. Taylor, ¶ 0056; Gordon, col. 13, ll. 42-col. 14, l. 5; Figs. 3-5, 10-12.

9. Taylor teaches a method 1200 for retrieving assets from a server using primary and secondary storage and executed by a controller. When a requested title is located in the server’s primary storage, the streaming play track is sent to the subscriber at step 1215. If the requested title is not located in the primary storage, the method follows steps 1225 and 1230. If the user makes a “jump” request, the retrieved play track is streamed to the user beginning at the requested chapter at step 1235. If the user makes a “trick play” request, the retrieved trick play track (e.g., FF or REW) is streamed to the user beginning at the requested entry point at step 1250. Taylor, ¶¶ 0074-79; Fig. 12.

10. Taylor discusses using different compressed video streams (e.g., MPEG or other compression schemes) for fast play and fast reverse play tracks. They include intracoded frames (i.e., I-frames), forward predictively coded frames (i.e., P-frames), and/or bidirectional predicted frame (i.e., B-frames). By using a compressed video stream, a predefined presentation speed ratio is established between the play track and trick play tracks and latency is reduced. Taylor, ¶ 0082.

ANALYSIS

Based on the record before us, we find no error in the Examiner's obviousness rejection of representative claim 1 which calls for, in pertinent part, identifying factors relevant to the information handling capability. While the Specification provides examples of "factors" (FF 3), the Specification does not define "factor" or an "information handling capability." Thus, giving the phrase "information handling capability" its broadest, reasonable construction, we find this phrase covers functions relating to handling information, including those associated with a movie, such as: play, reverse, and fast forward. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)(internal citations omitted). Also, given the breadth of the word "factor" in light of the Specification, a factor "relevant to a provision of the information handling capability" can include a user's request, the time of day, coding schemes, speed, and latency. Using these constructions, we turn to Taylor.

Taylor discloses a data management device for storing and retrieving data in response to a user's request. FF 4. Taylor discloses the user can request a product (e.g., a movie, package of movies, or subscription) that

contains different assets or information handling capabilities (e.g., play, preview, fast forward, rewind, navigation screens, promotional videos). FF 5. Taylor therefore teaches at least one factor (e.g., request sent by user) identified by a server relevant to these information handling capabilities. Moreover, Taylor teaches other identified factors relevant to these information handling capabilities. These factors include: compression schemes (e.g., including I-frames, P-frames, or B-frames); speed ratio; and latency. *See* FF 10. Other factors may include viewing time, use time, price, purchase rules, and encryption methodologies, related to the user's product rights that enable a server's controller to determine what a user may do with a service. *See* FF 6. Taylor's server must also identify the address of the client so that the product's and assets' elements are sent to the correct requested user. *See* FF 7. Taylor therefore teaches, as explained above, the server (1) identifies many factors (e.g., client's request, viewing time, coding, client's address) relevant to a provision of different information handling capabilities (e.g., play, preview, rewind, fast forward), and (2) selects a product or asset (e.g., play or preview a movie segment) to be uploaded to the client computer based upon these identified factors using a demand pull algorithm. Based on the Appellants' definition (FF 2), Taylor therefore teaches selecting a service (e.g., an algorithm for pulling play request) from among other services (e.g., algorithm for pulling preview or rewind).

Taylor also discloses the product and its associated assets are published and delivered to the customer's user interface so that the product becomes part of the user interface. *See* FF 7. In order to publish, deliver, and integrate such a product with its information handling abilities into the

client's user interface, the client must be provided with some executable code, executable process, or data used in the executable process for each information handling function (e.g., asset). *See id.* That is, Taylor teaches selecting a "service," as defined by Appellants (FF 2), so as to deliver the selected service to the client. For example, Taylor incorporates Gordon's applets teaching by reference which implement the user interface menus. *See* FF 7-8. Additionally, as each of these services (e.g., code related to play or preview) disclosed in Taylor has different abilities (e.g., play or preview a movie), the executable code associated with a service's menu and presented to the user interface must differ.

We therefore find that Taylor teaches services (e.g., executable process or code) that provides for functions of the information handling capabilities (e.g., play, preview) to be realized at the client computer. Additionally, as stated above, we find that Taylor teaches selecting the service (e.g., executable process or code for providing play or preview) based upon identified factors (e.g., user's request, viewing time, and client's address) and delivering the service to the client computer as recited in claim 1. *See* FF 4-10. Since Taylor teaches the services comprise different executable code, we find Kikuchi is cumulative.

Independent claims 12 and 15 are commensurate in scope, and we affirm the Examiner's rejection of these claims for the above reasons.

For the foregoing reasons, Appellants have not shown error in the obviousness rejection of independent claim 1 based on Taylor and Kikuchi. We therefore affirm the rejection of claim 1, and claims 2, 9, 13, 16, 18, and 19 which fall with independent claims 1, 12, and 15.

Claims 3, 14, and 17

Representative claim 3 recites the factors include one or more of the following: the operating system of the server or client, bandwidth between the client and server, date and/or time of day, cost for connection between client and server, and location of the client or server. The Examiner relies on Kikuchi to teach this limitation. Ans. 5-6. Appellants contend that the cited portion of Kikuchi fails to teach these factors. Br. 11-12.

The issue before us, then, is as follows:

ISSUE

(5) Under § 103, has the Examiner erred in rejecting claim 3 by finding that Taylor and Kikuchi collectively would have taught or suggested an identifying factor that includes either the time of day or the client's location?

ANALYSIS

Based on the record before us, we find no error in the Examiner's obviousness rejection of representative claim 3 which calls for, in pertinent part, the factors to comprise the time of day or client's location. As discussed above, we find that Taylor must locate the client's address or a location in order for the product and its capabilities to be published and become part of the client's overall user interface. *See* FF 5-7. Thus, Taylor includes a client's location identifying factor used to select the service to be uploaded to a client. Additionally, as stated above, Taylor discusses other factors, such as viewing time or use time, one of which represents the time of day, that enable a server's controller to determine what a user may do

with a product. *See* FF 5-6. This factor is additionally used in selecting a service to be uploaded to the client computer at a given time. We therefore again find Kikuchi merely cumulative.

Claims 14 and 17 depend from independent claims 12 and 15. As discussed above, we affirmed the obviousness rejection of independent claims 12 and 15, and will similarly affirm the rejection of claims 14 and 17 for the reasons stated above regarding claims 3, 12, and 15.

For the foregoing reasons, Appellants have not shown error in the obviousness rejection of claim 3, 14, and 17 based on Taylor and Kikuchi.

Claims 4-8, 10, and 11

Representative claim 4 recites the information handling capabilities comprise providing brokerage information to a user of the client computer system. The Examiner finds that this limitation is taught by Kikuchi (Ans. 6), but Appellants disagree. Br. 12.

The issue before us, then, is as follows:

ISSUE

(6) Does claim 4 recite non-functional descriptive material that is given no patentable weight?

PRINCIPLES OF LAW

All claim limitations must be considered when determining patentability. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). However, the Examiner does not need to give patentable weight to

nonfunctional descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *Gulack*, 703 F.2d at 1385.

ANALYSIS

Based on the record before us, we find no error in the Examiner's obviousness rejection of representative claim 4 which calls for, in pertinent part, the information handling capability to comprise providing brokerage information to the user of the client computer system. We find this limitation merely describes the content of the information, and thus comprises descriptive material. Additionally, the recited brokerage information has no functional relationship between its descriptive material and the substrate (e.g., a client computer). *See Ngai*, 367 F.3d at 1338; *Gulack*, 703 F.2d at 1385. The recited brokerage information is merely provided to the user of the computer, and no functional relationship exists between the computer and the information such that the computer has been given a property it would not have had if either the computer or information changed. This information also does not distinguish the computer from a prior art system that was the same except for the information or data provided. *See Ex parte Nehls*, 88 USPQ2d 1883, 1887-89 (BPAI 2008) (precedential).

Accordingly, the recited "brokerage information" is nonfunctional descriptive material and does not patentably distinguish over the prior art that otherwise renders claim 4 unpatentable. We therefore find that neither Taylor nor Kikuchi need to teach the information handling capability comprises providing "brokerage" information to the user. As Taylor

provides the client or user with *information* (e.g., titles, features such as play, preview, rewind) that is part of the information handling capability (FF 5-7), we find that Taylor teaches all the limitations of claim 4.

Claim 6 depends from claim 5 and recites the product information⁹ is real estate property. Claim 10 depends from claim 1 and recites “providing financial information to the user.” Like claim 4, we find the recited product information and financial information are no more than non-functional descriptive material. That is, no functional relationship exists between the computer and the product or financial information such that the computer has been given a property it would not have had if either the computer or information changed.

For the foregoing reasons, Appellants have not shown error in the obviousness rejection of claims 4, 6, and 10 based on Taylor and Kikuchi and claims 5, 7, 8, and 11 which fall with claims 4, 6, and 10.

Claims 20-38

Claim 20 recites a method executed by the client computer system that stores executable code for providing the information handling capability, performing an analysis on the usage of the capability by the client computer system, and unloads the executable code in response to the determination. The Examiner finds that Taylor teaches this limitation. Ans. 7-8. Appellants argue that Taylor teaches performing the analysis at the server. Br. 12-13.

⁹ Claim 6 recites “said product.” However, claim 6 also depends from claim 5 which recites “product information.” In order for “said product” to have proper antecedent basis, we presume that claim 6 was intended to recite “said product information.”

The issue before us, then, is as follows:

ISSUE

(7) Under § 103, has the Examiner erred in rejecting claim 20 by finding that Taylor and Kikuchi collectively would have taught or suggested performing analyzing usage by the client computer system at the client computer system?

ADDITIONAL FINDINGS OF FACT

11. Taylor performs an analysis to determine whether to retain assets on a primary storage device. Taylor, ¶ 0073.

12. Taylor states the server has a storage server 110 and secondary storage 130. Taylor discloses the storage server has host controller 210. Taylor, ¶¶ 0024-25; Figs. 1-2.

13. Taylor discloses the storage server is the primary storage. Taylor, ¶ 0057; Fig. 8.

ANALYSIS

Based on the record before us, we find error in the Examiner's obviousness rejection of claim 20 which calls for, in pertinent part, the client computer system to perform the analysis of the client computer system's usage. Taylor teaches performing an analysis to determine whether to retain assets or information handling capabilities on a primary storage device. FF 11. The Examiner has interpreted this primary storage device as the client

computer system's storage device. *See* Ans. 8. However, we agree with Appellants (Br. 12-13) that the primary and secondary storage discussed in Taylor addresses the server's storage.

Taylor discloses a process to determine whether to retrieve assets or information handling capabilities from primary storage using a controller. FF 9. Such a controller (e.g., 210) is located on the server side. FF 12. Taylor states the server has a storage server and secondary storage. *Id.* Taylor also explains the storage server is the primary storage. *See* FF 5 and 13. Thus, when reading Taylor as a whole, we find that Taylor analyzes the usage on the server rather than on the client computer system as recited in claim 20. The Examiner also has provided no evidence on the record that an ordinarily skilled artisan would have recognized based on Taylor's teachings to perform the analysis on the client side or unload the information handling capabilities process from the client's storage. Furthermore, Kikuchi does not cure this deficiency. We therefore find based on the evidence of record Taylor and Kikuchi do not collectively teach or suggest all the limitations in claim 20.

Independent claims 31 and 34 include commensurate limitations to claim 20 and likewise fail to teach executing the analysis of the client computer's usage at the client computer system.

We therefore find that the Examiner erred in rejecting independent claims 20, 31, and 34 based on the above obviousness rejection. Likewise, we will not sustain claims 21-30, 32, 33, and 35-38 because they depend directly or indirectly from claims 20, 31, and 34.

Claims 39, 45, and 48-51

Representative independent claim 39 recites the client computer system (1) receives from the server executable code for providing information handling capabilities, receives state information from the server relating to a prior interaction of the client and server computer systems, and uses the state information while executing the code at the client to provide the information handling capability. The Examiner finds that Taylor teaches all the limitations except for the executable code. Ans. 8. Appellants argue that Kikuchi does not receive state information related to a prior interaction of the client system and server, and Taylor does not relate to managing the client's states. Br. 13-14.

The issue before us, then, is as follows:

ISSUE

(8) Under § 103, has the Examiner erred in rejecting claim 39 by finding that Taylor and Kikuchi collectively would have taught or suggested receiving state information from the server relating to a prior interaction of the client and server computer?

ANALYSIS

Based on the record before us, we find no error in the Examiner's obviousness rejection. As discussed above, Taylor teaches the client computer receives executable code from the server in the form of a product that is published and integrated into the overall user interface. *See* FF 7. These products include assets, such as fast forward and fast reverse tracks. FF 5. Additionally, Taylor teaches the user can make a jump request (e.g.,

request a chapter) or a trick mode request. FF 9. Many of these functions require the user to send some information relating to the point or location where the movie is currently being played (e.g., point in the movie currently being played) so that the server can begin to stream the requested chapter (e.g., 1235) or begin the trick play track retrieval at the proper entry point (e.g., 1250). *Id.* Thus, the server will forward to the client state information (e.g., next chapter or new entry point) relating to the prior interaction of the client and server (e.g., the last chapter or point previously being viewed by the client) so the client can use the state information and execute code to provide the proper jump or trick mode function (e.g., playing requested or retrieved tracks associated with steps 1235 or 1255).

We therefore disagree with Appellants that Taylor (Br. 13-14) fails to teach receiving from the server state information relating to a prior interaction of the client and server computer systems. Moreover, the recitation to the state information *relating to a prior interaction of the client and server computer systems* can be considered non-functional descriptive material. While the state information is used by the client to provide information handling capabilities or exhibits a functional interrelationship with the client computer as recited in claim 39, the descriptive portion relating the prior interaction has no functional relationship to the client computer.

Independent claims 48 and 49 are commensurate in scope with claim 39 and will be affirmed for the above reasons.

For the foregoing reasons, Appellants have not shown error in the obviousness rejection of independent claim 39 based on Taylor and Kikuchi. We therefore affirm the rejection of claims 39, 48, and 49, and claims 45, 50, and 51 which fall with independent claims 39 and 49.

Claims 40-44, 46, and 47

Claims 40-44, 46, and 47 depend directly or indirectly from claim 39. Additionally, claims 40 and 41 are commensurate in scope with claims 4 and 5; claims 42 and 43 are commensurate in scope with claims 6 and 7; and claims 46 and 47 are commensurate in scope with claims 10 and 11. For the reasons discussed above regarding claims 39 and 4, we will affirm the rejection of claim 40 and claims 41 and 42 which depend directly or indirectly from claim 40. Similarly, for the reasons discussed above regarding claim 39 and 6, we will affirm the rejection of claim 42 and claim 43, which falls with claim 42. Lastly, for the reasons discussed above regarding claim 39 and 10, we will affirm the rejection of claim 46 and claim 47, which falls with claim 46.

Claims 52, 58, and 61-64

Representative independent claim 52 recites a method that includes the server selecting a service from at least two services to be executed by the server in response to a request to provide an information handling capability to the client computer and executing code¹⁰ in the service to provide the information handling capability. The Examiner finds that the combination of Taylor and Kikuchi teaches all of these features. Br. 7-8. Appellants

¹⁰ Claim 52 recites “said executable code” in the first instance.

argue that Kikuchi does not teach a server selecting a service to be executed and Taylor only relates to managing data between primary and secondary storage on the server and not to the selection and delivery of services. Br. 14.

The issue before us, then, is as follows:

ISSUE

(8) Under § 103, has the Examiner erred in rejecting claim 52 by finding that Taylor and Kikuchi collectively would have taught or suggested selecting a service to be executed by the server in response to the request to provide an information handling capability by the client computer system?

ANALYSIS

Based on the record before us, we find no error in the Examiner's obviousness rejection of claim 52. As discussed above, Taylor teaches more than managing data within the server's storage. For example, in addition to the services described above (e.g., fast forward and rewind), Taylor teaches selecting a streaming video service from at least a first and second service (e.g., stream at requested chapter and stream at requested point) in response to a request to provide an information handling capability (e.g., jump request and trick mode request). FF 9. Additionally, the actual streaming is executed by code (e.g., another service) at the server. *Id.* That is, the streaming is executed on the server side to provide video frames for the information handling capability of jumping a chapter or streaming to a

requested point. *Id.* Contrary to Appellants' contentions (Br. 14), we therefore find that the combination of Taylor and Kikuchi teaches selecting a service to be executed by the server in response to a request to provide an information handling capability.

Independent claims 61 and 62 are commensurate in scope with claim 52 and likewise teach selecting a service to be executed by a server.

We therefore find that the Examiner has not erred in rejecting independent claims 52, 61, and 62 based on the above obviousness rejection. Likewise, claims 58, 63, and 64 will be affirmed because they depend directly or indirectly from claims 52 and 62.

Claims 53-57, 59, and 60

Claims 53-57, 59, and 60 depend directly or indirectly from claim 52. Additionally, claims 53 and 54 are commensurate in scope with claims 4 and 5; claims 55 and 56 are commensurate in scope with claims 6 and 7; and claims 59 and 60 are commensurate in scope with claims 10 and 11. For the reasons discussed above regarding claims 52 and 4, we will affirm the rejection of claim 53 and 54. Similarly, for the reasons discussed above regarding claim 52 and 6, we will affirm the rejection of claims 55 and 56. Lastly, for the reasons discussed above regarding claim 52 and 10, we will affirm the rejection of claim 59 and 60.

CONCLUSION

The Examiner did not err in rejecting (1) claims 15, 34, 49, and 62 under § 101, and (2) claims 1-19 and 39-64 under § 103. The Examiner, however, erred in rejecting claims 20-38 under § 103.

ORDER

The Examiner's decision rejecting claims 1-64 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

pgc

WOOD, HERRON & EVANS, L.L.P. (IBM)
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OH 45202